

REMARKS

In the Office Action mailed 8/25/2004, Claims 1-5, 8, and 10-13 were rejected as being anticipated by the prior art under 35 U.S.C. §102(b). Claims 6, 7, 9, 14 and 15 were rejected as being obvious over the prior art under 35 U.S.C. § 103. Claims 16-18 and 19 were canceled. Claims 6, 7 and 14 were further rejected under 35 U.S.C. §112, second paragraph as being indefinite.

In response, Applicant has amended claims 1, 3-4, 6-7, 10, and 14-15 in view of the prior art, as discussed below. Claims 6, 7 and 14 were amended in view of the Examiner's rejection as being indefinite. Applicant has canceled claims 2, 13 and 19. Applicant has further added new independent Claim 20.

In view of the amendment and the argument presented below, Applicant respectfully traverses the rejection of the claims and requests that these pending claims be allowed.

Patentability of Claims 1-5, 8, 10, 12 and 13 (as amended)

These claims stand rejected under 35 U.S.C. §102(b) as being anticipated by Kysela, U.S. Patent No. 2,453,920. Applicant respectfully traverses the rejection of these amended claims for the reasons set forth below after a discussion of the teachings of this reference.

R. Kysela, U.S. Patent Number 2,453,920

Kysela is a "flower and candy display package." The "package" is a sealed, "filled container 10" having candies and the like, with a second or "outer cover 21" attached over the top of the filled container 10. When attached over the filled container 10, the cover 21

forms a “compartment 22” above the filled container 10 wherein a florist can place flowers (prior to attaching the cover 21 over the container 10). Kysela, then, is a dry container (i.e. item 10) encased within or beneath a wet container (i.e. the cover 21).

Kysela fails to disclose each and every element of Applicant’s Claims 1-5, 8, 10, 12 and 13 (as amended)

By combining the elements of various well-known decisions, one can see that a prima facie case of anticipation is established only when the Examiner provides:

1. a single reference¹
2. that teaches or enables²
3. each of the claimed elements (arranged as in the claim)³
4. expressly or inherently⁴
5. as interpreted by one of ordinary skill in the art.⁵

If the Examiner fails to produce a prima facie case of unpatentability, “then without more the applicant is entitled to the grant of the patent.”⁶

Here, independent claims 1 and 10 both recite, among other important limitations not found in this reference, a “wet vessel” that is “insertible” into the “top opening” of a “dry vessel.” As discussed above, Kysela is a cover attachable over a “container” – the container, then is inserted into the bottom opening of the cover. Furthermore, the two

¹ *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

² *Akzo N.V. v. U.S. Int’l Trade Comm’n*, 808 F.2d 1471, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986) (citing *In re Brown*, 329 F.2d 1006, 1011, 141 USPQ 245, 249 (CCPA 1964).

³ *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ at 485.

⁴ *Continental Can Co. USA v. Monsanto Co.*, 20 USPQ 2d at 1749-50.

⁵ *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

⁶ *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992).

containers are nested in reverse order; the Kysela container for dry materials resides within the container for the non-dry materials (the cover) – Applicant's claimed invention is the reverse. As such, Kysela fails to recite each and every element of Applicant's claimed invention in the order claimed, and therefore it fails to anticipate Applicant's claimed invention and this ground for rejection should be withdrawn.

Furthermore, nothing in Kysela hints or suggests Applicant's claimed design, and as such, Kysela fails to render Applicant's claimed design obvious.

Patentability of Claims 1-3, 10 and 11 (as amended)

These claims stand rejected under 35 U.S.C. §102(b) as being anticipated by Yellin, U.S. Patent No. 3,992,811. Applicant respectfully traverses the rejection of these amended claims for the reasons set forth below after a discussion of the teachings of this reference.

Yellin, U.S. Patent Number 3,992,811

Yellin is a "sand painting unit 10." The "unit 10" is a pair of nested containers, with the "inner member 14 spaced from the outer member 12" to create a space 18 between the two "members" or containers. The space, or "reduced width area 18" "forms a container" between the inner member 14 and the outer member 12 "to receive grains or particles of sand. *Abstract, also Column 2, lines 5-20.* The inner member 14 can be used for live plants. *See Figure 4.*

Yellin fails to disclose each and every element of Applicant's Claims 1-3, 10 and 11 (as amended)

The test for a prima facie case of anticipation is provided above. Applying that test here, independent claims 1 and 10 both recite, among other important limitations not found in this reference, a "wet vessel" that is "insertible" into the "top opening" of a "dry vessel," where said wet vessel is insertible into said dry vessel top opening, but prevented from being insertible into said bottom chamber and said wet vessel top is substantially adjacent to said dry vessel top opening.

In contrast, the Yellin "outer member" is defined by a single container having "an upstanding continuous flange" 26 or 56 which "positions and centers the inner unit 14 with respect to the outer unit 12 to provide sand-receiving spaces." The Yellin "flange" is not the same as Applicant's "bottom chamber" because the walls of the flange do not transition into the throat that terminates in the dry vessel top opening; instead, the walls of the Yellin flange terminate in the flange opening. Consequently, Yellin fails to recite each and every element of Applicant's claimed invention in the order claimed, and therefore it fails to anticipate Applicant's claimed invention and this ground for rejection should be withdrawn. Also, nothing in Yellin suggests or hints at Applicant's claimed design, and therefore an obvious rejection would be unsupportable by this reference, either alone or in combination.

Patentability of Claims 6, 7, 9, 14 and 15 (as amended)

These claims stand rejected under 35 U.S.C. §103(a) as being obvious in view of the combination of Kysela and Honkawa, U.S. Patent No 6,145,245. Applicant respectfully traverses the rejection of these amended claims for the reasons set forth below after a discussion of the teachings of the Honkawa reference.

Honkawa et al., U.S. Patent Number 6,145,245

Honkawa is a "floral bouquet and keepsake assembly." It has a "container 10 having an upright probe 12 projecting vertically from the center of the container 10." "A receptacle" for holding a "keepsake" is attached to the top end of the "probe 12." While Honkawa does teach the use of floral foam in the container 10, it does not discuss a pair of nested vessels.

The combination of Kysela and Honkawa fail to disclose each and every element of Applicant's Claims 1-5, 8, 10, 12 and 13 (as amended)

A prima facie case of obviousness is established only when the Examiner provides:

1. one or more references⁷
2. that were available to the inventor⁸
3. where the reference(s) teach⁹
4. a suggestion to combine or modify the reference(s)¹⁰

⁷ *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

⁸ See *In re Daminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986).

⁹ *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986) (citing *In re Brown*, 329 F.2d 1006, 1011, 141 USPQ 245, 249 (CCPA 1964)).

¹⁰ *In re Lulu*, 747 F.2d 703, 223 USPQ 1257, 1258 (Fed. Cir. 1984).

5. the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.¹¹

Again, whether under rejection for anticipation or obviousness, if the Examiner fails to produce a prima facie case of unpatentability, "then without more the applicant is entitled to the grant of the patent."¹²

Neither Kysela or Honkawa disclose an invention as recited by Applicant's claims, namely, a "wet vessel" that is "insertible" into the "top opening" of a "dry vessel," where said wet vessel is insertible into said dry vessel top opening, but prevented from being insertible into said bottom chamber and said wet vessel top is substantially adjacent to said dry vessel top opening. Although Honkawa adds the use of floral foam, it adds nothing else to the combination, and therefore not all of the elements are taught by the combination. Since all of the elements are not taught by these references, either alone or in combination, the prima facie case cannot be sustained over the amended claims, and these claims must therefore be allowed.

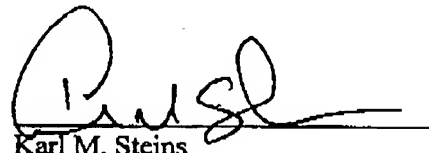
¹¹ *Rockwell Int'l Corp. v. United States*, 147 F.3d 1358, 47 USPQ 2d 1027, 1033 (Fed. Cir. 1998).
¹² *In re Oetiker*, 977 F.2d 1444, 24 USPQ 2d 1444 (Fed. Cir. 1992).

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests that the application be reconsidered, the claims be allowed, and the case passed to issue.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Karl M. Steins', written over a horizontal line.

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